

REMARKS

The rejections made in the Office Action of March 29, 2004 raise essentially two issues. As to the claims which recite use of a blend of polyaspartic ester, the rejection is under 35 USC 103 based on the combination of Luthra in view of Roesler. The claims which are not limited to use of a blend of polyaspartic ester have been rejected under 35 USC 102 as being anticipated by Luthra. The present amendment is designed to address both issues.

Picking them up in reverse order, claims 29-43 have been amended to overcome the rejection based upon Luthra. Thus, those claims all now recite that the polyurea coating composition is "non aqueous" and it "cures dry to handle after air drying at 72° F and 40% relative humidity in less than 120 minutes". Luthra, on the other hand discloses an aqueous polyurea coating composition having a much slower drying time.

Luthra does, however, contain some comparison examples wherein the coating compositions did not contain water. Apparently, the examiner relies upon comparison example 1 as being anticipatory. But, example 1 shows a set to touch of 6.5 hours, a surface dry of 13 hours and a hard dry of 17.5 hours. That means that the drying times of Luthra example 1 are considerably longer than those of the present invention as now quantified by the limitation that the dry to handle curing time is less than 2 hours.

In that regard, the examiner states "--- it isn't clear if the dry times testing method used by Luthra are comparable to those of applicant. When a reference discloses all the limitations of a claim except for a property, and the examiner can't determine if the property is inherent, the burden of proof is shifted to the applicant ---." In meeting that burden of proof, applicant attaches hereto the Declarations of Richard E. Milhem and Kent E. Best, which demonstrates that there is, in fact a considerable difference in the drying times. As indicated in the Milhem Declaration, the closest Luthra drying test method to the claimed "dry to handle" test method is the surface dry test of Luthra. Example 1 of Luthra shows surface dry at 13 hours, over 6 times the maximum recited in claims 29-43.

As stated by the court in *In re Papesch*, 137 USPQ 43, 51 (CCPA 1963).

"From the standpoint of patent law, a compound and all of its properties are

inseparable; they are one and the same thing. --- And the patentability of the thing does not depend upon the similarity of its formula to that of another compound but of the similarity of the former compound to the later. There is no basis in law for ignoring any property in making such a comparison. An assumed similarity based on a comparison of formulae must give way to evidence that the assumption is erroneous."

Here the vast difference in the drying time property demonstrates that the claimed composition is different from and patentable over the composition of example 1 of Luthra.

As to the rejection based upon the combination of Luthra and Roesler, it should be noted that claims 22-28 have been amended to recite that the polyurea coating composition is "non-aqueous." Luthra discloses an aqueous polyurea coating composition. Roesler discloses a non-aqueous one. It would not have been obvious to one of ordinary skill in the art to combine the two.

Rather, as pointed out in the Milhem Declaration, Luthra and Roesler each teach away from the combination of the two references. Why would one of ordinary skill in the art, even if it were obvious to use a blend of polyaspartic esters in Luthra, remove the water from the composition as well? Luthra specifically teaches away therefrom. For example Luthra at column 2, lines 8-10 states "by using water as a non-organic solvent improved application characteristics can be achieved --- ."

MPEP section 2145X.D.2 specifically provides that "it is improper to combine references where the references teach away from their combination." Here that is the case. One of ordinary skill in the art in view of the teaching of Luthra would not remove the water therefrom and one of ordinary skill in the art in view of the teaching of Roesler would not add water thereto.

Besides, if the references were combined in the manner suggested by the examiner, it would destroy the intended function. Luthra's whole intent is to provide an aqueous polyurea coating composition. Removing water would defeat that intent. The whole purpose of Roesler is to make a non-aqueous polyurea coating. Adding water would defeat his intent. The Federal Circuit has consistently held that when a section 103 rejection is based upon a

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modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference, such a proposed modification is not proper and the prima facie case of obviousness cannot be properly made out. That is the situation here.

For the foregoing reasons, it is submitted that all of the remaining claims, as amended, patentably distinguish over the prior art of record. Reconsideration and allowance are respectfully requested.

If the Examiner has any questions or comments regarding the present application, please contact the undersigned at the telephone number indicated below.

Respectfully submitted,  
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